Supreme Court, U.S.
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No. ____

IN THE SUPREME COURT OF THE UNITED STATES

October Term 1995

THE UNIVERSITY OF HOUSTON, ARTE PUBLICO PRESS AND NICHOLAS KANELLOS IN HIS OFFICIAL CAPACITY

Petitioners,

v.

DENISE CHAVEZ

Respondent.

PETITION FOR WRIT OF CERTIORARI

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QUESTIONS PRESENTED FOR REVIEW

A. WHETHER CONGRESS' AMENDMENTS TO THE COPYRIGHT ACT AND THE LANHAM ACT WHICH PURPORT EXPRESSLY TO ABROGATE TEXAS SOVEREIGN IMMUNITY TO SUIT IN FEDERAL COURT ARE CONSTITUTIONAL IN LIGHT OF THE ELEVENTH AMENDMENT.

B. WHETHER THE COURT SHOULD OVERRULE ITS DECISIONS IN *PENNSYLVANIA V. UNION GAS COMPANY* AND *PARDEN V. TERMINAL RAILWAY OF ALABAMA DOCKS DEPARTMENT.*

C. WHETHER THE COURT SHOULD GRANT CERTIORARI IN LIGHT OF THE COURT'S ANTICIPATED HOLDING IN *SEMINOLE TRIBE OF FLORIDA V. STATE OF FLORIDA*, ET AL., NO. 94-12, AND IN LIGHT OF THE COURT'S POSSIBLE DECISION IN THE *OHIO AGRICULTURAL COMMODITY DEPOSITORS FUND, ET AL. V. MAHERN, TRUSTEE*, NO. 95-561, BECAUSE THOSE DECISIONS MAY CHANGE THE PRECEDENTIAL LANDSCAPE UPON WHICH THE OPINION OF THE COURT OF APPEALS WAS BASED.

PARTIES

The parties in this case are:

1. The University of Houston; Arte Publico Press, a component of the University of Houston; and Nicholas Kanellos, in his representative capacity as publisher of Arte Publico Press, as petitioners,

2. and Denise Chavez, as respondent.

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The Opinion of the United States Court of Appeals for the Fifth Circuit, filed August 1, 1995, in Case No. 93-2881, is reported as *Denise Chavez v. Arte Publico Press, et al*; 59 F.3d 539 (5th Cir. 1995), and is reproduced at A-1.

The Order of the United States District Court, Southern District of Texas, filed November 4, 1993, is unreported and is reproduced at A-21.

The Memorandum of the United States District Court, Southern District of Texas, filed November 5, 1993, is unreported and reproduced at A-22.

The Order of the U.S. Court of Appeals for the Fifth Circuit denying the Petition for Rehearing filed August 30, 1995 is unreported and reproduced at A-23.

JURISDICTIONAL STATEMENT

The opinion and judgment of the United States Court of Appeals for the Fifth Circuit in this case was entered on August 1, 1995, (A-1). On August 30, 1995, the Fifth Circuit entered an order denying a timely motion for rehearing. Jurisdiction is invoked pursuant to 28 U.S.C. § 1254(1).

In the District Court jurisdiction was invoked by the Plaintiff/Respondent under 28 U.S.C. § 1338 and/or 28 U.S.C. § 1367(a).

In the Court of Appeals for the Fifth Circuit jurisdiction was invoked by the University under 28 U.S.C. § 1291.

CONSTITUTIONAL AND STATUTORY PROVISIONS INVOLVED

Eleventh Amendment, United States Constitution.

The Judicial power of the United States shall not be construed to extend to any suit in law or equity, commenced or prosecuted against one of the United States by Citizens of another State, or by Citizens or Subjects of any Foreign State.

The Copyright Act, 17 U.S.C. § 501

(a) Anyone who violates any of the exclusive rights of the copyright owner as provided by sections 106 through 118 or of the author as provided in section 106A(a) ... is an infringer of the copyright or right of the author, as the case may be .... As used in this subsection the term "anyone" includes any State, any instrumentality of a State, and any officer or employee of a State or instrumentality of a State acting in his or her official capacity.

Any State, and any such instrumentality, officer, or employee, shall be subject to the provisions of this title in the same manner and to the same extent as any nongovernmental entity.

The Copyright Act, 17 U.S.C. § 511

(a) In general.—Any State, any instrumentality of a State, and any officer or employee of a State or instrumentality of a State acting in his or her official capacity, shall not be immune, under the Eleventh Amendment of the Constitution of the United States or under any other doctrine of sovereign immunity, from suit in Federal court by any person, including any governmental or nongovernmental entity, for a violation of any of the exclusive rights of a copyright owner provided by sections 106 through 119 ... or for any other violation under this title.

(b) Remedies.—In a suit described in subsection (a) for a violation described in that subsection, remedies (including remedies both at law and in equity) are available for the violation to the same extent as such remedies are available for such a violation in a suit against any public or private entity other than a State, instrumentality of a State, or officer or employee of a State acting in his or her official capacity. Such remedies include impounding and disposition of infringing articles under section 503, actual damages and profits and statutory damages under section 504, costs and attorney's fees under section 505, and the remedies provided in section 510.

The Lanham Act, 15 U.S.C. § 1122

(a) Any State, instrumentality of a State or any officer or employee of a State or instrumentality of a State acting in his or her official capacity, shall not be immune, under the eleventh amendment of the Constitution of the United States or under any other doctrine of sovereign immunity, from suit in Federal court by any person, including any governmental or nongovernmental entity, for any violation under this chapter.

(b) In a suit described in subsection (a) of this section for a violation described in that subsection, remedies (including remedies both at law and in equity) are available for the violation to the same extent as such remedies are available for such a violation in a suit against any person other than a State, instrumentality of a State, or officer or employee of a State or instrumentality of a State acting in his or her official capacity. Such remedies include injunctive relief under section 1116 of this title, actual damages, profits, costs and attorney's fees under section 1117 of this title, destruction of infringing articles under section 1118 of this title, the remedies provided for under sections 1114, 1119, 1120, 1124 and 1125 of this title, and for any other remedies provided under this chapter.

STATEMENT UNDER RULE 29.4(b)

Pursuant to Rule 29.4(b), Rules of the Supreme Court, 28 U.S.C. § 2403(a) may be applicable because the constitutionality of 17 U.S.C. §§ 501(a) and 511, and 15 U.S.C. §1122 is drawn into question. Pursuant to this Rule, service is being made on the Solicitor General.

The United States Court of Appeals for the Fifth Circuit has, pursuant to 28 U.S.C. § 2403(a), certified to the Attorney General the fact that the constitutionality of such Act of Congress has been drawn into question.

STATEMENT OF THE CASE

NATURE OF THE CONTROVERSY

Put succinctly, the issue in this case is whether the Eleventh Amendment of the United States Constitution bars a suit in Federal Court against a Texas university, the University of Houston, for alleged violations of the Copyright and Lanham

Acts. At the core of this issue is the question of Congress' power to abrogate a state's sovereign immunity to suit affirmed under the Eleventh Amendment to the United States Constitution.

The University of Houston is a public institution of higher education established by the State of Texas, and funded and operated in accordance with Texas law. Tex. Educ. Code Ann. § 111.01 et seq., Appropriations Act, 1989, 71st Leg., 1st C.S., Session Laws, Ch. 1263, p. 5624; Appropriations Act, 1991, 72nd Leg., 1st C.S., Session Laws, Ch. 19, p. 875; Appropriations Act, 1993, 73rd Leg., Session Laws, Ch. 1051, p. 5161; Appropriations Act, 1995, 74nd Leg., Session Laws, Ch. 1063, p. 5554. Arte Publico Press ("Press") is a constituent part of the University operating under the auspices of and controlled by the University. Nicholas Kanellos is a state employee who acted on behalf of the Press, and therefore on behalf of the University. Kanellos is the official responsible for the operations of the Press including the negotiation and performance of the Publishing Agreement(s) in dispute. Kanellos in his official capacity, the Press and the University are legally indistinguishable, for which reason this Petition refers to them collectively as "the University."

Chavez is a resident of New Mexico who has a commercial relationship with the University. This relationship with the University began in 1984 when Chavez entered into an agreement with The University to publish a book entitled The Last of the Menu Girls ("the Book"). Successive publishing agreements followed, culminating in an agreement executed April 15, 1991 ("the Agreement"), the legal import of which is disputed. Several printings of the Book were made under these multiple publishing agreements.

A dispute arose about the duration of the 1991 license granted to the University in the Agreement. When the University planned a new printing of the Book, Chavez claimed that the license terminated upon the printing of the first 2,000 copies of the Book described in an addendum to the Agreement. Chavez is

suing the University claiming that the University will violate her copyright by further publications.

The University also published an anthology of plays entitled Shattering the Myth ("the Anthology"), and stated in a 1992 catalogue that Chavez was a selector of the plays. Chavez admits that she agreed to and did select the plays published in the Anthology, but complains that the truthful identification of herself as selector is a misrepresentation of sponsorship or approval in violation of the Lanham Act.

COURSE OF THE PROCEEDINGS BELOW

Chavez filed an action in the U.S. District Court, Southern District of Texas on August 12, 1993, alleging that The University and Kanellos, in both his official and individual capacities, infringed her copyright in The Last of the Menu Girls, falsely represented that she was a selector of the plays in the Anthology, and violated an alleged right to publicity protected by State law by listing her as a selector of the Anthology. Chavez also sought a declaratory judgment as to the jural and legal relations of the parties with respect to the series of publishing agreements for the Book.

Kanellos in his official capacity and the University filed a motion to dismiss, contending they were immune under the Eleventh Amendment.[1] The trial court held that Congress had abrogated Texas' Eleventh Amendment immunity and refused to dismiss, allowing the lawsuit to proceed. See, Appendix, p. A-22.

Kanellos and the University appealed this decision and challenged the constitutionality of Congressional abrogation under

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[1] Kanellos also sought dismissal of the suit against himself personally on the basis of qualified immunity. The Court of Appeals ruled in his favor on this issue, for which reason that issue is not made a part of this Petition.

the Copyright and Lanham Acts. The court of appeals affirmed, in part, the trial court's decision. It upheld the trial court's denial of sovereign immunity as to the University for acts occurring after the amendments to the Copyright and Lanham Acts. The court of appeals concluded that Congress can abrogate a state's Eleventh Amendment immunity and had done so in the Copyright Act and the Lanham Act.

This petition challenges Congress' authority to abrogate Texas' Eleventh Amendment immunity.

REASONS FOR GRANTING THE WRIT

A. Certiorari Should Be Granted To Determine Whether the Eleventh Amendment As Explained in Existing Precedent Is Such a Limitation on the Power of the Federal Courts That Texas' Immunity From Suit Cannot Be Abrogated By Congress.

The statutes at issue in this case—the Copyright Act and the Lanham Act—are both predicated on Congress' Article I powers. The Copyright Act was enacted pursuant to Congress' power under Article I, Section 8, clause 8, "[t]o promote the Progress of Science and useful Arts, by securing for limited Times to Authors ... the exclusive Right to their ... Writings." The Lanham Act was enacted pursuant to Congress' Interstate Commerce Clause powers. Both statutes contain explicit language making clear Congress' intent to abrogate the States' Eleventh Amendment immunity from suit by any person for a violation of the statutes' other provisions. Despite the clear expression of its intent to do so, it is the University's position that Congress cannot use power granted to it under Article I of the Constitution to abrogate Eleventh Amendment immunity.

As written, the Eleventh Amendment is a clear limitation on the judicial power of the United States. As such, it clearly limits

the federal courts' jurisdiction under Article III of the Constitution. The fallacy of the Respondent's position thus far in this case is simply that it fails to recognize that nothing in Article I authorizes Congress to expand the jurisdiction of the federal courts beyond the bounds set in Article III.

This premise has been clearly enunciated for over a century. In *Hans v. Louisiana*, 134 U.S. 1 (1890), this Court was faced with a suit brought by a citizen of Louisiana against that State alleging that the case arose under the Constitution or laws of the United States. The Court expressly reviewed sovereign immunity law, *Chisholm v. Georgia*, 2 U.S. 419 (1794), and the aftermath of the Chisholm decision. The Court concluded that "[t]he truth is that the cognizance of suits and actions unknown to the law, and forbidden by the law, was not contemplated by the constitution when establishing the judicial power of the United States." *Hans v. Louisiana*, 134 U.S. at 15. In other words, Article III must be viewed in the context of the general common law extant at the time of the adoption of the Constitution.[2] Given the unanimous acceptance of the notion of sovereign immunity among the states in 1789, the Court in Hans found the notion that States could be sued under an assertion of federal question jurisdiction "almost an absurdity on its face." Id.

This view was reiterated in *In Re: State of New York*, 256 U.S. 490 (1921). The Court wrote:

> That a state may not be sued without its consent is a fundamental rule of jurisprudence having so important a

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[2] This method of analysis is followed in the context of other immunity controversies as well. *See Owen v. City of Independence*, 445 U.S. 662 (1980) (holding that there was no tradition of municipal immunity at the adoption of the Civil War Era Civil Rights Act, and therefore no municipal immunity under 42 U.S.C. § 1983); *Will v. Michigan Dep't of State Police*, 491 U.S. 58 (1988) (holding that neither the State nor its officials acting in their official capacities are persons under 42 U.S.C. § 1983); *City of Newport v. Fact Concerts, Inc.* 453 U.S. 247 (1981) (holding that municipalities were immune from the imposition of punitive damages under 42 U.S.C. § 1983).

> bearing upon the construction of the Constitution of the United States that it has become established by repeated decisions of this court that the entire judicial power granted by the Constitution does not embrace authority to entertain a suit brought by private parties against a state without consent given; not one brought by citizens of another state, or by citizens or subjects of a foreign state, because of the Eleventh Amendment; and not even one brought by its own citizens, because of the fundamental rule of which the amendment is but an exemplification.

Id. at 497.

Since that time there have been frequent calls to overrule Hans and its successor cases. See, *Welch v. Texas Dep't of Highways and Pub. Transp.*, 483 U.S. 468, 478 (1987) (Brennan, J., dissenting); *Papasan v. Allain*, 478 U.S. 265, 293 (1986) (Brennan, J., concurring in part and dissenting in part); *Green v. Mansour*, 474 U.S. 64, 74 (1985) (Brennan, J., dissenting); *Atascadero State Hosp. v. Scanlon*, 473 U.S. 234, 247 (1985) (Brennan, J., dissenting). The Court has declined to do so. Indeed, the Court expressly endorsed Hans in *Blatchford v. Native Village of Noatak* 501 U.S. 775 (1991) as recently as 1991.

As was stated in *Dellmuth v. Muth*, "abrogation of sovereign immunity upsets the fundamental constitutional balance between the Federal Government and the States, placing a considerable strain on the principles of federalism that inform Eleventh Amendment doctrine." 491 U.S. 223, 227 (1989) (citations omitted). That strain shows in this case, in which the Court of Appeals stated:

> A State's immunity from suit in federal court has a turbulent past, an enigmatic present and an uncertain future. *Chavez v. Arte Publico Press*, 59 F3d 539, 541.

In order to relieve this strain the Court needs to reexamine and reiterate these precedents. The failure to do so will signify that Article I powers, including those represented by the Necessary and Proper Clause[3], may be used to justify a tremendous and unwarranted expansion of the power of the Federal government at the expense of the States.

B. Certiorari Should Be Granted To Overrule *Pennsylvania v. Union Gas Co.* and *Parden v. Terminal Railway of Alabama Docks Department.*

Ultimately, this court must choose to reaffirm Hans and the principle for which it stands or to obviate 200 years of jurisprudence based on the Eleventh Amendment, Hans and their progeny. In contrast to Hans, two anomolous lines of cases have arisen which have eroded the State's protection under the Eleventh amendment. These are exemplified by this Court's decisions in *Pennsylvania v. Union Gas Co.*, 491 U.S. 1 (1989), and *Parden v. Terminal Ry. of Ala. Docks Dep't*, 377 U.S. 184 (1964). Both cases are fundamentally opposed to the principles enunciated from *Hans* to *Blatchford*, for which reason they should be explicitly overruled.

Article III, § 2 defines the jurisdiction of the federal courts. As expressed originally by the Framers, the States can arguably be said to have consented to federal court jurisdiction in three instances. These include "Controversies between two or more States;—between a State and Citizens of another State;...and between a State, or the Citizens thereof, and foreign States, Citizens or Subjects." U.S. CONST. art. III, § 2. Despite the arguable clarity of this language, the issue was raised soon after

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[3] Article I, § 8, Cl. 18 states:

> To make all Laws which shall be necessary and proper for carrying into Execution the foregoing Powers, and all Powers vested by this Constitution in the Government of the United States, or in any Department or Officer thereof.

adoption that the Constitution was not intended to abolish or modify the common law doctrine of sovereign immunity. The Supreme Court in *Chisholm v. Georgia*, 2 U.S. 419 (1794) considered that issue and these provisions for the first time. In that case the Court held that suits based upon diversity jurisdiction could be instituted by private parties against States in federal court.

The aftermath of *Chisholm* was swift. The Eleventh Amendment was proposed to the State legislatures on March 4, 1794; ratification was completed on January 8, 1798.

Although the text of the Amendment speaks in terms of diversity jurisdiction, the Eleventh Amendment has come to be viewed much more broadly. In *Hans v. Louisiana*, supra, the Court considered the question of whether "a state can be sued in a circuit court of the United States by one of its own citizens upon a suggestion that the case is one that arises under the constitution or laws of the United States." 134 U.S. at 9.[4] The Court answered this question in the negative.

The significance of *Hans* to this case cannot be diminished. Federal question jurisdiction is the only basis of federal court jurisdiction available to the Respondent in this case. It was this basis that the Court considered in *Hans*. It was this basis that was rejected by the Court in favor of sovereign immunity.

As a limitation on Eleventh Amendment immunity the Court has recognized that Eleventh Amendment immunity can be, and in specific cases has been, waived. At the same time, however, the

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[4] This reiterates the position of Justice Iredell in *Chisholm*, who recognized that Art. III should be construed to conform to, rather than supplant, the common law in place at the time the Constitution was ratified. As summarized by Justice Bradley almost 100 years later, Justice Iredell "contended that it was not the intention to create new and unheard of remedies, by subjecting sovereign states to action at the suit of individuals...but only, by proper legislation, to invest the federal courts with jurisdiction to hear and determine controversies and cases, between the parties designated, that were properly susceptible of litigation in courts." *Hans v. Louisiana*, 134 U.S. 1, 12 (1890).

Court has recognized that such a waiver of Eleventh Amendment immunity must be explicitly expressed. *Pennhurst State School & Hosp. v. Halderman*, 459 U.S. 89 (1984); *Atascadero State Hosp. v. Salmon*, 473 U.S. 234 (1985). Thus, a state does not waive immunity in federal court simply by waiving its immunity to suit in its own courts. *Pennhurst*, 465 U.S. at 99.

In particular, the Court has recognized a limited waiver of immunity in the "plan of the convention" where it is clear that such a waiver is inherent in the relationship of the state and federal governments established by the Constitution. The Court has recognized such a waiver, however, in only two categories of cases: suits among sister states, e.g. *South Dakota v. North Carolina*, 192 U.S. 286 (1904), and suits by the United States, See *United States v. Texas*, 143 U.S. 621 (1892). Similarly, the Court has recognized a waiver of sovereign immunity growing out of the enforcement provisions of the Fourteenth Amendment. *Fitzpatrick v. Bitzer*, 427 U.S. 445 (1976). However, it has refused to extend such waiver to Indian Tribes (*Blatchford v. Native Village of Noatak*, 501 U.S. 775 (1991)) or foreign governments (*Monaco v. Mississippi*, 292 U.S. 313 (1934)).

Pennsylvania v. Union Gas is a troublesome case that seeks to apply "plan of the convention" analysis to the exercise of Article I powers. In it five Justices appeared to agree that Congress had the power to abolish Eleventh Amendment immunity through the exercise of its Interstate Commerce Clause power. The five Justices did not agree, however, on the basis for that conclusion. Four Justices appeared to agree that the ratification of Article I waived immunity, effectively seeking to return the Court to the position it espoused in Chisholm. The final Justice concurred for reasons best described as cryptic, but which clearly rejected the "plan of the convention" theory.

Against the plurality's argument, Justice Scalia properly noted that "that principle is too much at war with itself to endure." 491 U.S. at 45 (Scalia, J. with Rehnquist C.J., and O'Connor and Kennedy J.J., concurring in part and dissenting in part). This

opinion recognizes that to hold that the States consented to Congressional abrogation of their immunity effectively repudiates *Hans* in the face of the Court's stated unwillingness to do so. Such a contradiction cries out for clarification.

At the same time, the Court is here presented with an opportunity to address again *Parden v. Terminal Ry. of Ala. Docks Dep't*, 377 U.S. 184 (1964), a FELA case brought by citizens of Alabama against a railroad owned and operated by Alabama in interstate commerce. Parden stands for the proposition that states may impliedly, as opposed to expressly, consent to federal court jurisdiction by acting in a sphere subject to Congressional regulation. It served as the basis of the holding of the Court of Appeals.

Parden was partially overruled in *Welch v. Texas Dep't of Highways and Pub. Transp.*, 483 U.S. 468 (1987), a case noteworthy because it lacked a majority opinion and overruled Parden to the extent that Parden was inconsistent with the requirement that an abrogation of Eleventh Amendment immunity must be clearly expressed; however, Welch expressly withheld ruling on the issue of Congressional power to abrogate Eleventh Amendment immunity to the extent that the States are engaged in interstate commerce. This case presents the Court with another opportunity to address this issue.

A subsequent case calls into question whether Parden is still good law. In *Blatchford, supra,* the Court recognized only two methods under which a State could consent to suit in federal court: "either expressly or under the plan of the convention." 501 U.S. at 779. Implicit in this pronouncement is the understanding that waiver by implication, as espoused in Parden, is not a valid analysis by which to conclude that a States' immunity from suit in federal court had been waived.

Similarly, it is necessary to overrule *Parden* and *Union Gas* to reconcile the language of the Court in *Fitzpatrick, supra.* The

Court in *Fitzpatrick* stated that Section 5 of the 14th Amendment allows suits against States "which are constitutionally impermissible in other contexts." *Fitzpatrick*, 427 U. S. at 456. If *Parden* and *Union Gas* stand, effectively allowing abrogation of State sovereign immunity in any situation in which Congress is empowered to regulate under the vast scope of its Article I powers, there would be no "constitutionally impermissible context" which sets apart Section 5 of the 14th Amendment. As Justice Scalia stated in *Union Gas*: "To acknowledge that the Federal Government can make the waiver of state sovereign immunity a condition to the State's action in a field that Congress has authority to regulate is substantially the same as acknowledging that the Federal Government can eliminate state sovereign immunity in the exercise of its Article I powers--that is, to adopt the very principle I have just rejected." 491 U.S. at 44. (Scalia concurring in part and dissenting in part).

The importance of these issues, especially in light of the frequency with which they have recurred before this Court in recent years and the fragmented nature of this Court's recent decisions in this area, are an appropriate basis on which to base a decision to hear this case.

C. Certiorari Should Be Granted In Light of The Court's Anticipated Decision in *Seminole Tribe of Florida v. State of Florida*, et al., No. 94-12, and In Light of the Court's Possible Decision in *The Ohio Agricultural Commodity Depositors Fund, et al. v. Mahern, Trustee*, No. 95-561, Because Those Decisions May Change the Precedential Landscape Upon Which The Opinion of The Court of Appeals Was Based.

Presently pending before this Court is *Seminole Tribe of Florida v. State of Florida, et al.*, No. 94-12, which was argued October 11, 1995. Similarly, the State of Ohio filed a Petition for Writ of Certiorari on September 28, 1995 under the style, *The Ohio Agricultural Commodity Depositors Fund, et al. v. Mahern,*

Trustee, No. 95-561. While not squarely on point as to all issues, both of these cases raise an issue that may determine the outcome of this case.

In *Seminole Tribe of Florida* this Court is faced with issues posed by Congress' enactment of the Indian Gaming Regulatory Act, 25 U.S.C. § 2701 et seq. Specifically, the Court is asked to determine whether Congress has the power, despite the Eleventh Amendment, to authorize suits against States in Federal Court to enforce legislation pursuant to the Indian Commerce Clause, Article I, Section 8, Clause 3 of the Constitution.

In The Ohio Agricultural Commodity Depositors Fund, the Petitioners have raised similar, but not identical issues. In that case, the Petitioners have placed before this Court issues relating to the Bankruptcy Act, specifically, the constitutionality of 11 U.S.C. § 106(a), which expressly abrogates sovereign immunity as to governmental units in bankruptcy matters.

In this case, the University has directly attacked the constitutionality of two statutes, the Copyright Act, 17 U.S.C. §§ 501 and 511 and the Lanham Act, 15 U.S.C. § 1122, to the extent that they abrogate the University's Eleventh Amendment immunity and subject the University to suit in federal court by an individual plaintiff. At the trial level the District Court simply denied the University's motion to dismiss on these grounds. The Court of Appeals recognized the constitutional issue raised by the University, but decided the case on an alternative—and the University would argue, an inconsistent—ground: implied waiver of Eleventh Amendment immunity under *Parden v. Terminal Ry. of Ala. Docks Dep't*, 377 U.S. 184 (1964).

The *Seminole Tribe* and *The Ohio Agricultural Commodity Depositors Fund* cases between them address two modes of analysis that impact this case. First, both cases seek a ruling from the Court that would distinguish Congress' power to abrogate Eleventh Amendment immunity under the Interstate Commerce

Clause, as recognized in *Pennsylvania v. Union Gas Co.*, 491 U.S. 1 (1989), from other Article I powers. In the *Seminole Tribe* case the power to be distinguished is that conferred by the Indian Commerce Clause; in *The Ohio Agricultural Commodity Depositors Fund* case the power to be distinguished is that conferred by the Bankruptcy Clause. Second, both cases seek to overturn *Pennsylvania v. Union Gas Co., supra.*

If either mode of analysis were accepted by this Court, it would have significance in this case. In the first instance, it would imply that the Patents and Copyright Clause could be plausibly distinguished from the Interstate Commerce Clause. This would require re-examination of the University's position at least as regards Chavez's copyright claim. In the second instance, the overruling of *Pennsylvania v. Union Gas* could require reversal and dismissal of all federal claims against the University.

CONCLUSION

Wherefore, for the above reasons, the University of Houston, Arte Publico Press and Nicholas Kanellos in his official capactity pray that certiorari be granted in this case.

Respectfully submitted,

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ATTORNEYS FOR PETITIONERS

November 28, 1995

No._____

IN THE SUPREME COURT OF THE UNITED STATES

October Term 1995

THE UNIVERSITY OF HOUSTON, ARTE PUBLICO PRESS AND NICHOLAS KANELLOS IN HIS OFFICIAL CAPACITY

Petitioners,

v.

DENISE CHAVEZ

Respondent.

APPENDIX

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APPENDIX A

IN THE
UNITED STATES COURT OF APPEALS
FOR THE FIFTH CIRCUIT

No. 93-2881

DENISE CHAVEZ,

Plaintiff—Appellee,

v.

ARTE PUBLICO PRESS, et al.,

Defendant—Appellants.

Appeal from the United States District Court
for the Southern District of Texas,
_____ Division.
No. _____-_____, Judge.

ARGUED _____-DECIDED
AUGUST 1, 1995

Before WISDOM, JONES and EMILIO M. GARZA, Circuit Judges. EDITH H. JONES, Circuit Judge.

The University of Houston and one of the employees appeal the denial of their motions to dismiss an action brought under the Copyright and Lanham Acts. Appellants principally contend that the Acts are unconstitutional under the Eleventh Amendment because they purport to override state immunity and authorize suits in federal court against the state for violation of the Acts. This would appear to be a compelling defense were it not for the vicissitudes of Supreme Court interpretation of the Amendment. As the Court's decisions now stand, the University's claim of sovereign immunity must fail, although its employee Kanellos prevails on qualified immunity

BACKGROUND[1]

Denise Chavez, the plaintiff/appellee, is a "nationally renowned playwright and dramatist ... with a unique and valuable reputation as a commentator on cultural issues regarding women and, in particular, Hispanic women." Chavez has resided in New Mexico at all times relevant to this lawsuit.

Arte Publico Press, the defendant/appellant, is a component part of the University of Houston and legally indistinguishable from the University. The University is owned and operated by the State of Texas. Nicholas Kanellos, also a defendant/appellant, is a University employee who at all times relevant acted on its behalf.

In July 1984, Chavez and the University entered into a contract for publication of her books. A year later, the University agreed to do a first printing of *The Last of the*

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[1] Because this is an appeal from the denial of a motion to dismiss under Federal Rule of Civil Procedure 12(b)(6) for failure to state claim on which relief may be granted, we take as true the facts alleged in the Complaint.

Menu Girls, a collection of Chavez's short stories. The book was published in 1986, and the copyright was registered in Chavez's name as author and owner. Twice in later years, the parties agreed on additional publishing contracts for *The Last of the Menu Girls*, each of which provided for a specified number of copies to be printed. Kanellos signed the contracts on behalf of the University.

In late 1991 and early 1992, Chavez dissatisfied that the University had failed to correct errors in the earlier printings, refused to permit the University to print any more copies than agreed to in the 1991 contract. On or about October 2, 1992, however, the University asserted to Chavez that the 1991 contract did not limit the number of copies it could print and declared its intention to print 5,000 more copies of the book.[2]

During this time period, the University also published an anthology of plays entitled *Shattering the Myth*. Chavez was identified in a University catalog as the selector of the plays. Chavez does not dispute this statement, but she objects that her identification as selector is a misrepresentation of sponsorship in violation of her right to publicity.

Chavez filed this action in 1993 in federal court. Her complaint alleges that the University and Kanellos, in both his official and individual capacities, infringed her copyright in her book, violated the Lanham Act in naming Chavez as the selector of the plays without her authority, and violated

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[2] The 1991 contract provides that the University shall have the exclusive right to publish the book for a term of at least five years and that only the University may terminate the contract during that term. The addendum to the contract specifies that the number of copies to be published is 2,000 trade paperbacks.

her state law right to publicity. Chavez seeks a declaratory judgment securing her rights under the contract, as well as damages, attorneys' fees, and an injunction against the University. Chavez invokes federal question and supplemental jurisdiction, but not diversity jurisdiction.

The University moved to dismiss on behalf of itself and Kanellos for failure to state a claim, resting *inter alia*, on Eleventh Amendment sovereign immunity. Kanellos also asserted his qualified immunity. The district court denied the motions, allowing the lawsuit to proceed. The University and Kanellos filed a timely interlocutory appeal on these issues. *Puerto Rico Aqueduct & Sewer Auth. v. Metcalf & Eddy, Inc.*, _____ U.S. _____, _____, 113 S.Ct. 684, 689, 121 L.Ed.2d 605 (1993).

DISCUSSION

A State's immunity from suit in federal court has a turbulent past, an enigmatic present, and an uncertain future. Our commission is to ascertain the current state of the law, guided by the historical evolution of sovereign immunity. The future of such immunity will ultimately be resolved by the Supreme Court, perhaps in a case pending this term. *See Seminole Tribe of Florida v. State of Florida*, 11 F.3d 1016 (11th Cir. 1994), *cert. granted*, _____ U.S. _____, 115 S.Ct. 932, 130 L.Ed.2d 878 (1995).

The highlights of sovereign immunity jurisprudence provide the necessary context for this discussion. The Constitution did not originally confer explicit immunity on the States against suits in federal court. Article III, section 2 extends the federal judicial power to controversies "between a State and Citizens of another State." In 1793, the Supreme Court exercised this grant of power and assumed original jurisdiction over a suit brought by a citizen of South Carolina

against the State of Georgia. *Chisholm v. Georgia*, 2 Dall., 419, 1 L.Ed. 440 (1793). This decision "created such a shock of surprise that the Eleventh Amendment was at once proposed and adopted." *Monaco v. Mississippi*, 292 U.S. 313, 325, 54 S.Ct. 745, 749, 78 L.Ed. 1282 (1934).

The Eleventh Amendment provides:

"The judicial power of the United States shall not be construed to extend to any suit in law or equity, commenced or prosecuted against one of the United States by Citizens or Subjects of any Foreign State."

That the Amendment's language overruled *Chisholm* was never disputed; whether the Amendment also affirmed the existence of immunity beyond the text, as later recognized in *Hans v. Louisiana*, 134 U.S. 1, 10 S.Ct. 504, 33 L.Ed. 842 (1890), has been the subject of intense debate.

In *Hans*, the Supreme Court held that the scope of sovereign immunity was not limited by the text of the Eleventh Amendment. Rather, the Amendment embodied the broader and more fundamental constitutional concept of state immunity from suit in federal court even against suits brought by its own citizens. A review of the constitutional debates concerning the scope of Article III persuaded the Court that federal jurisdiction over suits against unconsenting states "was not contemplated by the Constitution when establishing the judicial power of the United States." *Id* at 15, 10 S.Ct. at 507.[3] Although repeatedly called into

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[3] Thirty years later, the Court succinctly summarized its Eleventh Amendment jurisprudence after *Hans*:

> "That a State may not be sued without its consent is a fundamental rule of jurisprudence having so important a bearing upon the construction of the Constitution of the United States that it has become established by repeated decisions of this court that the entire judicial power granted

question by some of the Justices, *Hans* and its progeny remain the law. However, a State's general immunity from suit in federal court marks only the beginning of the inquiry.

A State is free to waive its immunity and consent explicitly to suit in federal court. *See e.g., Pennhurst State School & Hosp. v. Halderman*, 465 U.S. 89, 99, 104 S.Ct. 900, 907, 79 L.Ed. 2d 67 (1984); *Atascadero State Hosp. v. Scanlon*, 473 U.S. 234, 238, 105 S.Ct. 3142, 3145, 87 L.Ed. 2d. 171 (1985). Not only may the state expressly waive its immunity, but according to some opinions from the Supreme Court, waiver may occur in two other instances relevant to this case. The first theory of non-express waiver has been designated as the "plan of the [constitutional] convention" waiver; the second may be called "implied" or "*Parden*" waiver.[4]

The "plan of the convention" theory of state waiver of sovereign immunity was first highlighted in *Monaco v. Mississippi*, 292 U.S. 313, 54 S.Ct. 745, 78 L.Ed. 1282 (1934). The Court explained that "States of the Union, still possessing attributes of sovereignty, shall be immune from suits, without their consent, save where there has been a 'surrender of this immunity in the plan of the convention.'

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by the Constitution does not embrace authority to entertain a suit brought by private parties against a State without consent given: not one brought by citizens of another State, or by citizens of a foreign State, because of the Eleventh Amendment; and not even one brought by its own citizens, because of the fundamental rule of which the Amendment is but an exemplification." *Ex Parte State of New York*, 256 U.S. 490, 497, 41 S.Ct. 588, 589, 65 L.Ed. 1057 (1921).

[4] It has been held that in ratifying the Fourteenth Amendment, states waived immunity from suits authorized by Congress under section five of the Fourteenth Amendment. *Fitzpatrick v. Bitzer*, 427 U.S. 445, 456, 96 S.Ct. 266, 2671, 49 L.Ed.2d 614 (1976). Our resolution of this case does not warrant analysis under the Fourteenth Amendment.

The Federalist No. 81." *Id.* at 322-23, 54 S.Ct. at 748.[5] According to the plan of the convention theory, by ratifying the Constitution, States necessarily surrendered certain of their powers to the federal government. Implicit in the surrender was a consent to suit in federal court in certain cases. The Supreme Court has found such a waiver in two contexts: suits by Sister States, *South Dakota v. North Carolina*, 192 U.S. 286, 318, 24 S.Ct. 269, 275, 48 L.Ed. 448 (1904), and suits by the United States, *United States v. Texas*, 143 U.S. 621, 12 S.Ct. 488, 36 L.Ed. 285 (1892). Whether the States waived immunity from suits by *private parties* by ratifying the Constitution is not so clear. As will be discussed, the Supreme Court was confronted with this very question in *Pennsylvania v. Union Gas*, 491 U.S. 1, 109 S.Ct. 2273, 105 L.Ed.2d 1 (1989).

The second form of non-express waiver has been deemed to occur when a State participates for profit in a particular market or industry, and Congress, acting pursuant to the powers conferred upon it, in Article I of the Constitution, has explicitly conditioned that participation on a State's waiver of immunity from suit. Thus, in *Parden v. Terminal Ry. of Ala. State Docks Dept.*, 377 U.S. 184, 84 S.Ct. 1207, 12 L.Ed.2d 233 (1964), "Congress conditioned the right to operate a railroad in interstate commerce upon amenability to suit in federal court as provided by the [Federal Employers' Liability Act] ..." *Id.* at 192, 84 S.Ct. at 1213. *See also Employees of Dept. of Public Health & Welf. v. Missouri*, 411 U.S. 279, 285, 93 S.Ct. 1614, 1618, 36 L.Ed.2d 251 (1973) (in enacting the Fair Labor Standards

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[5] In *Monaco*, the Court ultimately held that because there existed "no ground upon which it can be said that any waiver or consent by a State of the Union has run in favor of a foreign State," Mississippi had not waived its immunity from suit by the foreign State of Monaco. *Monaco*, 292 U.S. at 330, 54 S.Ct. at 751.

Act, Congress did not condition operation of a not-for-profit State hospital on waiver of State immunity); *Atascadero State Hosp. v. Scanlon*, 473 U.S. 234, 247, 105 S.Ct. 3142, 3149-50, 87 L.Ed.2d 171 (1985) ("The Act ... falls far short of manifesting a clear intent to condition participation in the programs funded under the Act on a State's consent to waive its constitutional immunity.").

The State of Texas contends that neither theory of non-express waiver of sovereign immunity is viable against it in this case. Although Congress amended both the Copyright and Lanham Acts specifically to abrogate states' immunity from suit in federal court,[6] Texas asserts that these enactments violate recent Supreme Court Eleventh Amendment jurisprudence and are ineffective. First, in *Blatchford v. Native Village of Noatak*, 501 U.S. 775, 111 S.Ct. 2578, 115 L.Ed.2d 686 (1991), and earlier cases, the Court allegedly closed the door on the "plan of the convention" theory of non-express waiver. Second, the State

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[6] The Copyright Act provides in pertinent part:

> In general, any State, any instrumentality of a State, and any officer or employee of a State or instrumentality of a State acting in his official capacity, shall not be immune, under the Eleventh Amendment of the Constitution or under any doctrine of sovereign immunity, from suit in Federal Court by any person ... for a violation of any of the exclusive rights of the copyright owner provided by ... this Title.

17 U.S.C. § 511(a).

The Lanham Act provides in pertinent part:

> Any State, any instrumentality of a State or any officer or employee of a State or instrumentality of a State acting in his official capacity, shall not be immune, under the Eleventh Amendment of the Construction or under any doctrine of sovereign immunity from suit in Federal Court by any person ... for any violation under this chapter."

15 U.S.C. § 1122.

relies upon *Welch v. Texas Dept. of Highways & Public Transportations*, 483 U.S. 468, 107 S.Ct. 2941, 97 L.Ed.2d 389 (1987), which it contends, overruled *Parden v. Terminal Ry. of Alabama Docks Dept.*, 377 U.S. 184, 84 S.Ct. 1207, 12 L.Ed.2d 233 (1964). In overruling *Parden*, the Court rejected the theory that Congress may overcome a state's immunity from suit in federal court by legislating pursuant to Article I.

While it appears that the state's first argument is correct, and the plan of the convention theory has never been accepted by more than four justices in any case, we nevertheless conclude that Texas's interpretation of *Parden* is in error under current caselaw.

To explain these conclusions it is necessary to return to *Pennsylvania v. Union Gas, supra*, where the issue presented was whether Congress had the intent and power to abrogate state immunity from private suit in federal court for violation of a federal environment statute. A five-member majority of the Court held that the Comprehensive Environmental Response, Compensation, and Liability Act of 1980 (CERCLA), as amended by the Superfund and Reauthorization Act of 1986 (SARA), unmistakably conveyed Congress's intent to render States liable in federal court for cleanup costs recoverable under CERCLA.[7] *Union Gas*, 491 U.S. at 8, 109 S.Ct. at 2278. On the issue of congressional authority to compel a waiver, however, Justice Brennan mustered only a plurality for his oft-stated view[8]

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[7] Justices Marshall, Blackmun, Stevens, and Scalia joined this portion of Justice Brennan's opinion.

[8] *See Employees of Dept. of Public Health & Welf. v. Missouri*, 411 U.S. 279, 317-18, 93 S.Ct. 1614, 1634, 36 L.Ed.2d 251 (1973) (Brennan, J., dissenting); *Edelman v. Jordan*, 415 U.S. 651, 687, 94 S.Ct. 1347, 1368, 39 L.Ed.2d 662 (1974) (Brennan, J., dissenting); *Atascadero State Hosp. v. Scanlon*, 473 U.S. 234, 279-80, 105 S.Ct. 3142, 3166, 87 L.Ed.2d 171

that the states waived their immunity in the "plan of the convention." Applying their plan of the convention theory, Brennan's plurality held that Congress, acting pursuant to the Commerce Clause contained in Article I, section 8, was empowered to abrogate[9] Pennsylvania's sovereign immunity and authorize a private suit against the State in federal court. Four other justices vehemently dissented against the plan of the convention theory of waiver. *Id.* at 30-45, 109 S.Ct. at 2297-2304 (Scalia, J., concurring in part and dissenting in part).

Justice White cast the tie-breaking vote favoring abrogation of state sovereign immunity, although he also wrote on behalf of three other justices to dissent from the majority holding that CERCLA, as amended by SARA, was unmistakably clear in its intent to abrogate State immunity from suit in federal court. In a single terse paragraph, Justice White concurred individually in the Brennan plurality's conclusion that Congress has the power to abrogate sovereign immunity under its Article I powers, but he repudiated[10] the plurality's reasoning and reaffirmed his

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(1985) (Brennan, J., dissenting); *Welch v. Texas Dept. of Highways and Public Trans.*, 483 U.S. 468, 504-09, 107 S.Ct. 2941, 2962-65, 97 L.Ed.2d 389 (1987) (Brennan, J., dissenting).

[9] The plurality's term "abrogate" appears to be a misnomer. If the States waived their immunity in the plan of the convention, there would be no immunity to abrogate. *See, Employees of Dept.of Public Health & Welf. v. Missouri*, 411 U.S. 279, 282 n. 1, 93 S.Ct. 1614, 1616 n. 1, 36 L.Ed.2d 251 (1973). If, on the other hand, the States did not waive their immunity, Congress would have no power to abrogate it. *See Puerto Rico*, _____ U.S. _____, _____-_____, 113 S.Ct. 684, 687-88. But to be consistent with the Justices' terminology, this opinion will also use "abrogate."

[10] Earlier in his concurring opinion, Justice White also voiced his disagreement with the reasoning of plurality. *Id.* at 45, 109 S.Ct. at 2289 (White J., concurring in part and dissenting in part).

allegiance to *Hans*. *Id.* at 56-57, 109 S.Ct. at 2295-96 (White, J., concurring in part and dissenting in part).[11]

Justice White's concurrence must be taken on its fact to disavow the plan of the convention theory of waiver. This interpretation is consistent with his position in the Eleventh Amendment cases decided before and after *Union Gas*, as Justice White has repeatedly parted company from Justice Brennan's attempts to engraft a plan of the convention theory of waiver into the Constitution. *See, e.g., Parden*, 377 U.S. at 198-99, 84 S.Ct. at 1216 (White, J., dissenting from Justice Brennan's theory that the states surrendered a portion of their sovereignty when they granted Congress the power to regulate commerce); *Employees of Dept. of Public Health & Welfare v. Missouri*, 411 U.S. 279, 93 S.Ct. 1614, 36 L.Ed.2d 251 (1973); *Edelman v. Jordan*, 415 U.S. 651, 94 S.Ct. 1347, 39 L.Ed.2d 662 (1974); *Port Authority Trans-Hudson Corp. v. Feeney*, 495 U.S. 299, 110 S.Ct. 1868, 109 L.Ed.2d 264 (1990).

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[11] Justice White's conclusion on this issue in *Union Gas*, stated in full, is as follows:

> My view on the statutory issue has not prevailed, however, a majority of the Court has ruled that the statute, as amended, plainly intended to abrogate the immunity of the States from suit in the federal courts. I accept that judgment. This brings me to the question whether Congress has the constitutional power to abrogate the States' immunity. [FN8] In that respect, I agree with the conclusion reached by Justice Brennan in Part III of his opinion, that Congress has the authority under Article I to abrogate the Eleventh Amendment immunity of the States, although I do not agree with much of his reasoning.
>
> [FN8] As a preliminary matter, I reiterate my view that for the reasons stated by the plurality in *Welch v. Texas Dept. of Highways, supra*, at 478-88, 107 S.Ct. at 2944-54, *Hans v. Louisiana*, 134 U.S. 1, 10 S.Ct. 504, 33 L.Ed. 842 (1890), should not be overruled.

Union Gas, 491 U.S. at 57, 109 S.Ct. at 2296 & n. 8 (White, J., concurring in part and dissenting in part).

The plan of the convention theory thus received only four votes of approbation in *Union Gas* and failed to become the constitutional law of the land. Despite his repeated efforts to secure a fifth vote in other cases, Justice Brennan, concurring in *Feeney, supra*, essentially conceded that the plan of the convention theory of waiver had never succeeded in capturing the Court's majority. *Feeney*, 495 U.S. at 310-11, 110 S.Ct. at 1875-76. And if further proof be needed, the Court's opinion in *Blatchford*, decided after *Union Gas* and concurred in by Justice White, pointedly observed that in only two classes of cases had the Court recognized that states waived immunity from suit in the plan of the convention—suits by sister states and suits by the United States. *Blatchford*, 501 U.S. at 780, 111 S.Ct. at 2582. No mention was made of waiver or abrogation of immunity in the face of congressional action pursuant to Article I.

On this basis, we therefore agree with the state of Texas that Chavez may not defend the express abrogation of state sovereign immunity in the Copyright and Lanham Acts by reference to a plan of the convention theory of waiver.[12]

In uneasy juxtaposition, however, with his (and the Court's) disavowal of the plan of the convention theory of waiver stands Justice White's conviction that Congress may under some circumstances require state waiver of immunity

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[12] Chavez urges this court to mechanically apply the holding of *Peel v. Florida*, 600 F.2d 1070 (5th Cir. 1979), in which we found a waiver in the plan of the convention for legislation passed pursuant to Congress' Article I war powers. *Id.* at 1080. However, since *Peel* was decided, the intervening Supreme Court decisions cited herein have rejected this theory of waiver. *Accord Seminole Tribe of Florida v. Florida*, 11 F.3d 1016 (11th Cir. 1994), *cert. granted*, _____ U.S. _____, 115 S.Ct. 932, 130 L.Ed.2d 878 (1995) (Judge Tjoflat, the author of both *Peel* and *Seminole Tribe*, does not follow *Peel* presumably because of the intervening Supreme Court decisions).

in federal court as the price for conducting business regulated by Congress. He first articulated this position, which includes a requirement that Congress must expressly abrogate state sovereign immunity, in *Parden, supra:*

Only when Congress has clearly considered the problem and expressly declared that any State which undertakes given regulable conduct will be deemed thereby to have waived its immunity should courts disallow the invocation of this defense.
Parden, 377 U.S. at 198-199, 84 S.Ct. at 1216 (White, J., dissenting).

He later joined in an opinion that limited the reach of *Parden* as follows:

The *Parden* case in final analysis turned on the question of waiver, a majority of the Court holding that it was a federal question since any consent of the State to suit did not arise from an act "wholly within its own sphere of authority" but in the area of commerce, which is subject to pervasive federal regulation.

Employees of Dept. of Public Health and Welfare v. Missouri, 411 U.S. 279, 284, 93 S.Ct. 1614, 1617, 36 L.Ed.2d 251 (1973). The Court there also noted that *Parden* involved a railroad business run by the State of Alabama for profit "in the area where private persons and corporations normally ran the enterprise." 411 U.S. at 284, 93 S.Ct. at 1617.

Finally, Justice White concurred in an opinion for a five-member majority that overruled *Parden* "to the extent that [it] is inconsistent with the requirement that an abrogation of the Eleventh Amendment immunity by Congress must be expressed in unmistakably clear

language." *Welch v. Texas Dept. of Highways & Public Transp.*, 483 U.S. 468, 477, 107 S.Ct. 2941, 2948, 97 L.Ed.2d 389 (1987). But *Welch* significantly declined "to consider the validity of the additional holding in *Parden*, that Congress has the power to abrogate the State's Eleventh Amendment immunity under the Commerce Clause to the extent that the States are engaged in interstate commerce." *Id.* at 477 n. 8, 107 S.Ct. at 2948 n. 8.

From Justice White's writing and concurrences in these earlier cases, we infer the meaning of his vote in *Union Gas* in favor of congressional abrogation of state immunity. The underlying suit in *Union Gas* alleged that Pennsylvania caused or contributed to the toxic release when it was excavating a creek for purposes of flood control. *Union Gas*, 491 U.S. at 5, 109 S.C. at 2277. Justice White evidently decided that if the majority's interpretation of the environmental statutes prevailed, that is, if Congress expressly determined to render states suable in federal court for cleanup costs, Congress had the power to do so under the Commerce Clause because, as in *Parden*, the states had voluntarily engaged in such regulated activities.

In the first section of his concurrence, Justice White highlights the portion of CERCLA, as amended by SARA, that exempts from liability costs incident to involuntary and emergency ownership by the State, except when the State has "caused or contributed" to the toxic release. *Id.* at 49-51 & n. 3, 109 S.Ct. at 2292-93 & n. 3 (White, J., concurring in part and dissenting in part). That Justice White determined that this affirmative conduct operated as an implied waiver of State immunity is suggested in a footnote. White posits:

But under § 9601(20(D), state and local governments are liable only if they have "*caused or contributed*" to a release of toxic materials. If § 9601(20(D) is the source of the

Eleventh Amendment *waiver*, and if, as the Court contends, its provisions are meant to address all state and local governments that own or operate toxic sites, then perhaps Congress *abrogated* the Eleventh Amendment only far enough to make States liable under this less stringent rule—whether they are voluntary or involuntary owners of a site. *Id.* at 53 n. 5, 109 S.Ct. 2292 n. 5. (emphasis added).

Justice White later adds, "Congress may have reasoned that while state and local governments that are involuntary owners should be exempted from liability under CERCLA, *those that actually cause* subsequent discharges should be liability under the statute ..." *Id.* at 54 n. 6, 109 S.Ct. at 2294 n. 6 (White, J., concurring in part and dissenting in part) (emphasis added). Therefore, Justice White, believing that for every Congressional abrogation under the Commerce Clause there must be an accompanying State waiver, apparently found an implicit waiver, similar to that in *Parden*, inherent in Pennsylvania's alleged conduct which caused or contributed to the toxic release.[13] Justice

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[13] Additional circumstantial supporting evidence that was Justice White's theory of the cause is found in Justice Scalia's dissent.

After discussing why he and three of his colleagues rejected the plurality's application of the plan of the convention waiver to the Article I, section 8 context, Justice Scalia moves to the other potentially applicable type of waiver recognized by the Court, that of implicit waiver under *Parden*. As framed by Justice Scalia, the issue was whether, by its actions, "Pennsylvania voluntarily assumed the state liability for private suit" contained in CERCLA. *Id.* at 42, 109 S.C. at 2303 (Scalia, J., concurring in part and dissenting in part). Recognizing that the implicit waiver theory in *Parden* had not yet been overruled, Justice Scalia declared that the time to do so had arrived. *Id.* at 43, 109 S.Ct. at 2303 (Scalia, J., concurring in part and dissenting in part). He implicitly criticized Justice White's position: "[T]o acknowledge that the Federal Government can make the waiver of state sovereign immunity a condition to the State's action in a field that Congress has authority to regulate is substantially the same as acknowledging that the Federal Government can eliminate state sovereign immunity in the exercise

White's view, as the fifth vote for abrogation of sovereign immunity in *Union Gas*, must be taken as that of the Court. *See e.g., Schlup v. Delo*, _____ U.S. _____, _____, 115 S.Ct. 851, 877, 130 L.Ed.2d 808 (1995).

In summary, applying the Supreme Court's current Eleventh Amendment jurisprudence, we must conclude that although the implied waiver found in *Parden* has been narrowed considerably and called into question, it has never been overruled and, indeed, seems to have motivated Justice White's crucial fifth vote for concurrence in *Union Gas*. *Blatchford* did not touch on the *Parden* theory of waiver or implied consent. Until the Supreme Court determines otherwise, we must conclude that Congress is authorized expressly to compel states to waive sovereign immunity from private suits in federal courts under the narrow circumstances found in *Parden, i.e.*, when the states opt to conduct business for profit in areas where Congress conditions participation upon waiver of immunity.

Applying the foregoing discussion of states' immunity to this case is not difficult. Both the Copyright Act and the Lanham Act represent valid exercises of Congressional power under the Copyright Clause, Article I, section 8, clause 8 of the Constitution. Further, both of these statues were recently amended to express in clear and unmistakable language Congress's intent to abrogate State immunity from suit, as required by *Atascadero State Hosp. v. Scanlon*, 473 U.S. 234, 238, 105 S.Ct. 3142, 3145, 87 L.Ed.2d 171 (1985). Although we are aware of no cause that specifically holds that laws passed pursuant to the Copyright

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of its Article I powers—that is, to adopt the very principle I have just rejected." *Id.* at 44, 109 S.Ct. t 2304 (Scalia, J., concurring in part and dissenting in part). Justice Scalia would have had little reason to address *Parden* waiver had he not thought it relevant to Justice White's position.

Clause can abrogate State immunity, there is no principled reason to distinguish between this and other Article I, section 8 powers entrusted to Congress. *Accord Union Gas*, 491 U.S. at 42, 109 S.Ct. at 2303 (Scalia, J., concurring in part and dissenting in part). Since Texas has not expressly waived its immunity by statute or otherwise, the remaining question is whether Texas impliedly consented to suit by knowingly participating in the publishing business, in which Congress has expressly conditioned states' activity on a waiver of sovereign immunity.

Language intended to abrogate State immunity was added to the Copyright Act effective November 15, 1990, *see* note 6, *supra*, the amendment responded to court decisions holding that the absence of clear and unmistakable language precluded waiver of state immunity under the previously-discussed Supreme Court cases. *See, e.g., BV Engineering v. Univ. of Cal., Los Angeles,* 858 F.2d 1394, 1396 (9th Cir. 1988). Chavez and the University entered into a contract authorizing publication of *The Last of the Menu Girls* in 1991. According to the Complaint, the University notified Chavez in October, 1992 of its intent to publish more copies of the book than authorized in the contract. Chavez alleges that the University has published and distributed the additional copies and in so doing has infringed upon her copyright. The University's conduct in alleged violation of the agreement occurred after the 1990 amendment of the Copyright Act. Therefore, the University had notice that its continued participation in the publishing business for profit was conditioned by Congress upon a waiver of its immunity from suit in federal court for violations of the Copyright Act. What is left of *Parden* governs this suit. Accordingly, Chavez may proceed with her lawsuit against the University and Kanellos in his official capacity for alleged violations of the Copyright Act.

Unmistakably clear language intended to abrogate State immunity was also added to the Lanham Act effective October 27, 1992. *See* note 6, *supra*. The Complaint alleges that the University violated the Lanham Act when it published, without Chavez's consent, a catalog advertisement of a book entitled *Shattering the Myth*, which the catalog described as a collection of plays selected by Chavez. According to the Complaint, this catalog was published in or about September 1992—one month *before* the abrogation language was added to the Act. To the extent that the Complaint seeks redress for violations that allegedly occurred *before* the amendment was enacted, the State is immune. The State is not immune, however, from any action or relief sought by Chavez concerning conduct that occurred *after* the effective date of the amendment, when the University is deemed to have had notice of its contents.

Chavez conceded in oral argument that the abrogation of immunity in the Copyright Act and Lanham Act does not extend to state law causes of action. Her state law "right to publicity" cause of action is thus barred against the University and Kanellos in his official capacity.

We now turn to Kanellos's contention that he is qualifiedly immune from suit. Qualified immunity shields from liability government officials performing discretionary functions "as long as their actions could reasonably have been thought consistent with the rights they are alleged to have violated." *Anderson v. Creighton*, 483 U.S. 635, 638, 107 S.Ct. 3034, 3038, 97 L.Ed.2d 523 (1987); *see also Malley v. Briggs*, 475 U.S. 335, 341, 106 S.Ct. 1092, 1096, 89 L.Ed.2d 271 (1986) (qualified immunity protects "all but the plainly incompetent or those who knowingly violate the law"). This immunity is not merely immunity from liability, but is also immunity from suit, *Siegert v. Gilley*, 500 U.S. 226, 231, 111 S.Ct. 1789, 1793, 114 L.Ed.2d 277 (1991), and

it is effectively lost if a cause is erroneously permitted to go to trial. *Sorey v. Kellett*, 849 F.2d 960, 961 (5th Cir. 1988).

The dispositive question is "whether an objectively reasonable official would understand that the alleged improper actions were unlawful." *Del A. v. Edwards*, 855 F.2d 1148, 1151 (5th Cir. 1988).

The unlawful act Kanellos is alleged to have committed was authorizing the printing of copies of Chavez's book in violation of the Copyright Act. However, paragraph 14 of plaintiff's Complaint concedes that the contractual provision relating to the duration of the publishing license is ambiguous. The contract itself, appended to the plaintiff's Complaint, confirms this ambiguity. Because the licensing contract was reasonably susceptible to two interpretations, one of which renders Kanellos's alleged act perfectly legal, he is entitled to qualified immunity. *See Anderson*, 483 U.S. at 641, 107 S.Ct. at 3040 (officer entitled to qualified immunity if reasonable officer could have believed actions were lawful in light of information possessed).

Neither the Complaint nor plaintiff's appellate brief clearly states that Chavez is asserting causes of action against Kanellos in his individual capacity under the Lanham Act and for violating state law privacy rights. Therefore, because plaintiff has failed to allege facts which would enable her to recover against Kanellos in his individual capacity, he is entitled to qualified immunity. *See Elliott v. Perez*, 751 F.2d 1472, 1473 (5th Cir. 1985).

CONCLUSION

For the foregoing reasons, we AFFIRM that district court's denial of sovereign immunity for actions of the

University undertaken after the amendments to the Copyright and Lanham Acts. We REVERSE the finding that the University may be sued for invasion of state law privacy rights and REMAND with instructions to dismiss this cause of action. We also REVERSE the denial of qualified immunity for Kanellos and REMAND with instructions to dismiss all causes of action against him in his individual capacity.

AFFIRMED in part, REVERSED and REMANDED in part.

APPENDIX B

UNITED STATES DISTRICT COURT SOUTHERN DISTRICT OF TEXAS

DENISE CHAVEZ,	§	
	§	
Plaintiff,	§	
	§	
versus	§	Civil Action H-93-2460
	§	
ARTE PUBLICO, *et al.*,	§	
	§	
Defendants.	§	

ORDER

Arte Publico's motion to dismiss (#3) is denied.

Signed on November 2, 1993, at Houston, Texas.

Lynn N. Hughes
United States District Judge

{U.S. District Court, Southern District of Texas
Entered November 4, 1993, Michael N. Milby, Clerk,
by Deputy: B. Jarma}

APPENDIX C

UNITED STATES DISTRICT COURT SOUTHERN DISTRICT OF TEXAS

DENISE CHAVEZ,	§	
	§	
Plaintiff,	§	
	§	
versus	§	Civil Action H-93-2460
	§	
ARTE PUBLICO, *et al.*,	§	
	§	
Defendants.	§	

MEMORANDUM

Despite the Attorney General's voluminous and expensive research in support of the state's motion to dismiss, the Attorney General failed to discover that in 1990 Congress abrogated absoslutely and explicitly the Eleventh-Amendment immunity under the copyright law.
Signed on November 2, 1993, at Houston, Texas.

Lynn N. Hughes
United States District Judge

{U.S. District Court, Southern District of Texas
Entered November 5, 1993, Michael N. Milby, Clerk,
by Deputy: B. Jarma}

APPENDIX D

IN THE UNITED STATES COURT OF APPEALS
FOR THE FIFTH CIRCUIT

No. 93-2881

DENISE CHAVEZ,

Plaintiff-Appellee,

versus

ARTE PUBLICO PRESS, ET AL.,

Defendants-Appellants.

Appeal from the United States District Court for the
Southern District of Texas

ON PETITION FOR REHEARING
(August 30, 1995)

Before WISDOM, JONES and EMILIO M. GARZA, Circuit Judges.

PER CURIAM:

IT IS ORDERED that the petition for rehearing filed in the above case is denied.

ENTERED FOR THE COURT:

_____

EDITH H. JONES
United States Circuit Judge

(Clerk's Note: See FRAP and Local Rules 41 for Stay of the Mandate.)

(U.S. Court of Appeals Filed August 30, 1995, Charles R. Fulbruge III Clerk.)